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EXAMINER

NGUYEN, JENNIFER T

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANNA PIA SLOTHOWER, DAVID NORTHWAY,
WILLAIM ROBERT HANSEN, and LAWRENCE LAM

Appeal 2010-004176
Application 09/774,990
Technology Center 2600

Before DENISE M. POTHIER, BRUCE R. WINSOR, and
JENNIFER S. BISK, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

Invention

Appellants' invention relates to a touch screen assembly having a cover. *See* Abstract. Claim 1 is reproduced below with the key disputed limitations emphasized:

1. An integrated enclosure/touch screen assembly comprising:
a display mechanism;
a digitizer mechanism comprising a protective component and a digitizing element; and
a single piece cover enclosure for said touch screen assembly that is disposed over and fully encloses the top and sides of said touch screen assembly that has endpoints that are coincident with a bottom surface of said touch screen assembly wherein said digitizing element can be activated by contact made along the external surface of said single piece cover enclosure, and wherein said single piece cover enclosure forms a seal to protect said digitizer mechanism.

The Examiner relies on the following as evidence of unpatentability:

Takahata	US 6,556,189 B1	Apr. 29, 2003 (filed Apr. 21, 1999)
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Figure 1 and accompanying description (Spec. 10:11–11:10) of Appellants' Admitted Prior Art (AAPA).

The Rejection

The Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over AAPA and Takahata. Ans. 2-5.¹

¹ Throughout this opinion, we refer to (1) the Appeal Brief filed December 10, 2008; (2) the Examiner's Answer mailed March 31, 2009, and supplemented October 13, 2009; and (3) the Reply Brief filed May 28, 2009.

CLAIMS 1-15

The Contentions

Regarding representative claim 1, Appellants argue that AAPA and Takahata, alone or in combination, fail to teach the recited cover that is disposed over and fully encloses the top and sides of the touch screen assembly and that has endpoints that are coincident² with a bottom surface of the touch screen assembly. App. Br. 5-6. Specifically, Appellants contend that Takahata's Figures 9 and 11 show the cover being multiple pieces which are not coincident with the assembly's bottom surface and Takahata's Figure 10 shows a bag that surrounds the entire touch screen assembly having no endpoints. App. Br. 6. Appellants further assert that the recited cover having endpoints that are coincident with the touch screen's bottom surface is not merely a matter of design choice. App. Br. 7. Lastly,

² Notably, the term, "coincident," is not found in the disclosure.

| "Coincident" is defined as "occupying the same space or time."

Merriam-Webster Online Dictionary, *available at* <http://www.merriam-webster.com/dictionary/coincident> (last visited Sept. 25, 2012). The cover's endpoints as shown in Figure 3 of the disclosure are adjacent to the touch screen assembly's bottom surface, but arguably do not precisely occupy the same space (i.e., the exact same point). Figure 3 can be accurately described as having cover ends that are coplanar with the touch screen assembly's bottom surface. Likewise, for claim 16 and as shown in the disclosure's Figure 6, the cover element's (610) top surface and the supporting structure's (605) top surface are coplanar. For purposes of this opinion, we will presume that Appellants intended to recite (a) the cover's endpoints and the touch screen assembly's bottom surface are coplanar with each other in claims 1 and 9 and (b) the top surfaces of the cover element and the supporting structure are coplanar in claim 16. If prosecution continues, the Examiner should consider whether the recited term, "coincident" in claims 1, 9, and 16, is amenable to two or more plausible claim constructions and therefore ambiguous. *See Ex parte Miyazaki*, 89 USPQ2d 1208, 1215-16 (BPAI 2008)

Appellants argue the cited art would have to be modified to arrive at the claimed invention and that the art fails to teach or suggest such a modification absent impermissible hindsight. App. Br. 7-8.

Issue

Under § 103, has the Examiner erred in rejecting claim 1 by finding that AAPA and Takahata collectively would have taught or suggested a single piece cover enclosure that is disposed over and fully encloses the top and sides of a touch screen assembly and has endpoints that are coincident with a bottom surface of the assembly?

Analysis

Based on the record before us, we find no error in the Examiner's rejection of claim 1, which calls for a single piece cover enclosure that is disposed over and fully encloses the top and sides of a touch screen assembly and has endpoints that are coincident with a bottom surface of the assembly. Both the Examiner and Appellants agree that neither AAPA nor Takahata explicitly teaches this disputed limitation – namely where the endpoints of the cover are located. *See* Ans. 3-4; App. Br. 6-7. However, the Examiner relies on the concept of design choice in concluding the claimed location of the cover's endpoints would have been obvious to an ordinarily skilled artisan. Ans. 3-4, 6. Thus, the crux of the dispute lies on whether the Examiner has properly formulated a *prima facie* case of obviousness based in part on design choice.

An obviousness “analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim,” and we “can take

account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Thus, neither AAPA nor Takahata needs to explicitly teach the recited cover having endpoints coincident with the touch screen assembly’s bottom surface to render claim 1 obvious. *See id.* That being so, the Examiner notes (Ans. 6) that Takahata teaches the sealed characteristics can be improved upon by covering the touch panel’s periphery not in its entirety but, in portions, such as the sides where liquid leakage is likely to occur. Col. 11, ll. 54-59. This teaching in Takahata, at minimum, suggests to an ordinary skilled artisan to modify the cover in Takahata’s Figure 10 so that the cover enclosure is not disposed over the entire touch screen assembly’s surfaces, such as covering its top and sides but not the bottom. Also, contrary to Appellants’ assertion, this teaching in Takahata provides some reason to modify the cover enclosure without benefit of the disclosure (App. Br. 7; Reply Br. 2) or using impermissible hindsight (App. Br. 8).

Additionally, the Examiner further demonstrates that the claimed cover enclosure that is disposed over and fully encloses the touch screen assembly’s top and sides and has endpoints that are coincident with the touch screen assembly’s bottom surface would be an obvious matter of design choice within the skill of the art. *See* Ans. 3-4, 6-7. First, we see no change in the operation of the combined AAPA/Takahata assembly based on the location of cover’s endpoints whether the endpoints are coincident with the touch screen assembly’s bottom surface or not. *See In re Japiske*, 181 F.2d 1019, 1023 (CCPA 1950). Second, Appellants have not set forth any reason why the particular location of the endpoints (i.e., coincident with the touch screen assembly’s bottom surface) would result in a different function

or yield unexpected results. *See In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975); *see also In re Chu*, 66 F.3d 292, 298-99 (Fed. Cir. 1995).

Appellants' disclosure states that the cover is included to provide a secure moisture and dust-free environment and to protect against mechanical damage. Spec. 2:3-7; 10:14-16; 11:21-22. However, the disclosure attaches no significance to where the endpoints of the cover are located. *See id.* In fact, the disclosure does not even use the word "coincident." *See generally* Specification. Appellants further assert that the recited cover having endpoints that are coincident with the touch screen's bottom surface is not merely a matter of design choice. App. Br. 7. But, Appellants fail to set forth any reasons why the differences between the claimed location of the endpoints and the prior art would result in a different function or produce an unexpected result. *See id.* Mere assertions that are unsupported by factual evidence are entitled to little probative value. *Cf. In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

Lastly, Appellants argue Takahata teaches in Figure 10 a cover that has no endpoints. *See* App. Br. 6. We disagree. As the Examiner notes (Ans. 6), Takahata teaches the cover has endpoints that are sealed on the side. Col. 10, ll. 48-49; Fig. 10.

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of independent claim 1 and claims 2-15 not separately argued with particularity (App. Br. 4-8).

CLAIMS 16-20

The Contentions

Claim 16 differs in scope from claim 1 by reciting a bezel-less cover that has a top surface that is coincident with the top surface of a supporting structure. The Examiner finds that Takahata teaches in Figure 1 a cover element (e.g., 6) having a top surface that is coincident with the top surface of a supporting structure (e.g., sealing material 8). Ans. 7. The Examiner additionally refers to bag 43 being located on the top surface of a supporting structure to meet the recited “coincident” limitation. *Id.*

Among other things, Appellants assert that the upper film 6 in Takahata “is not coincident with the top surface of a supporting structure, but instead appears to be on top of any supporting structure.” App. Br. 10.

Issue

Under § 103, has the Examiner erred in rejecting claim 16 by finding that AAPA and Takahata collectively would have taught or suggested a bezel-less cover that has a top surface that is coincident with the top surface of a supporting structure?

Analysis

Based on the record before us, we find error in the Examiner’s rejection of claim 16. We agree with Appellants (App. Br. 10) that Takahata’s Figure 1 shows the cover element mapped by the Examiner (e.g., 6) lies over and covers the supporting structure mapped by the Examiner (e.g., 8). *See* Ans. 7 (citing to Fig. 1). As such, the cover element 6’s top surface does not coincide (i.e., is not co-planar) with to the top surface of the

supporting structure 8. Rather, the cover element's bottom surface lies over the supporting structure's top surface. *See id.*

Additionally, Takahata teaches in Figure 10 a bag 43 (e.g., a cover) has a top surface that covers the touch screen assembly, including any supporting structure. *See Fig. 10.* However, once again, this embodiment does not teach or suggest that the cover's top surface coincides (i.e., is co-planar) with the top surface of a supporting structure. The cover element (e.g., 43) rather covers any top surface of a supporting structure, such that the cover's bottom is in contact with the supporting structure's top surface.

For the above reasons, Appellants have persuaded us of error in the rejection of independent claim 16 and dependent claims 17-20 for similar reasons.

CONCLUSION

Under § 103, the Examiner did not err in rejecting claims 1-15 but erred in rejecting claims 16-20.

DECISION

The Examiner's decision rejecting claims 1-15 is affirmed but the Examiner's decision rejecting claims 16-20 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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